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EXAMINER

SHERR, CRISTINA O

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* HONG Q. BUI
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11 Appeal 2009-012815
12 Application 09/457,839
13 Technology Center 3600
14

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16 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
17 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
18 FETTING, *Administrative Patent Judge*.

19 DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Hong Q Bui (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 36-39, 41, 42, 44-52, 60-64, and 66-69, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellant invented a way of processing transactions over the Internet using an information service to provide customer information, including payment information, to a third party Internet merchant (Specification 1:7-10).

An understanding of the invention can be derived from a reading of exemplary claim 36, which is reproduced below [bracketed matter and some paragraphing added].

36. A system for providing a server-side wallet service, the system comprising:

[1] a service web site that provides functionality for users

to register with the wallet service and

to provide customer information and authentication information

for use of the wallet service,

² Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed October 23, 2006) and Reply Brief ("Reply Br.," filed December 30, 2008), and the Examiner's Answer ("Ans.," mailed December 11, 2008).

1 said customer information including
2 payment information
3 for making purchases from merchant web
4 sites that support customer use of the wallet
5 service; and

6 [2] a server system that
7 authenticates registered users of the wallet service and
8 disseminates the customer information
9 of the registered users
10 to the merchant web sites
11 in response to user requests,
12 the server system thereby allowing registered users of the
13 wallet service
14 to make purchases from the merchant web sites
15 using previously-specified customer information;

16 [3] wherein the server system is responsive to a request to
17 transfer the customer information of a registered user to a
18 selected merchant web site by at least

19 (1) using the authentication information of the registered
20 user to authenticate the registered user, and
21 (2) if the registered user is successfully authenticated,
22 sending customer information of the registered
23 user to the selected merchant web site
24 to permit the merchant web site to transact a sale to
25 the registered user,
26 whereby the system enables the registered user to make a
27 purchase from the selected merchant web site
28 without having a preexisting account with the
29 selected merchant web site; and

30 [4] wherein the server system
31 maintains a log of purchases made by the registered user
32 from each of a plurality of merchant web sites,

1 uses the log to generate an interests profile for the
2 registered user, and
3 disseminates the interests profile to the merchant web
4 sites
5 to allow the merchant web sites to provide
6 personalized content to the registered user.

7 The Examiner relies upon the following prior art:

Boesch	US 6,092,053	Jul. 18, 2000
Linehan	US 6,327,578 B1	Dec. 4, 2001
Katis	US 6,601,761 B1	Aug. 5, 2003
Foster (Prov Appl.)	US 60/152,651	Nov. 1, 2000

8 Claims 41, 42, 44, and 45 stand rejected under 35 U.S.C. § 101 as
9 directed to non-statutory subject matter.

10 Claims 36-39, 41, and 42 stand rejected under 35 U.S.C. § 103(a) as
11 unpatentable over Foster.

12 Claims 44, 45, and 67-69 stand rejected under 35 U.S.C. § 103(a) as
13 unpatentable over Boesch and Linehan.

14 Claims 46-52 and 60-64 stand rejected under 35 U.S.C. § 103(a) as
15 unpatentable over Katis.

16 ISSUES

17 The issue as to statutory subject matter hinges on whether the claims are
18 directed to no more than abstract concepts with only insignificant data
19 gathering and post solution activity. The issues as to obviousness hinge on
20 whether the claims narrowly require that data reside in certain places or
21 broadly move data that are not narrowly originated.

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FACTS PERTINENT TO THE ISSUES

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The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

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Facts Related to the Prior Art

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Foster

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01. Foster is directed to an online payment system in which the customer pays a merchant by sending payment information to the payment processor instead of the merchant. Foster 1:29-2:7.

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02. Foster maintains a log of transactions on the customer's computer, but does not describe transmitting this log to the merchant. Foster 6:5-8.

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Boesch

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03. Boesch is directed to presenting a consumer's purchasing information to a merchant's computer to allow a sale of goods or services to be consummated. Boesch 2:66-3:1.

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04. Boesch describes the existing electronic wallet process as including a step where a consumer sends information to make a purchase to a merchant web site. Some wallets are referred to as thin wallets. Boesch 3:13-63.

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05. Boesch stores a cookie identifying a user on the user's computer. Boesch 4:13-17.

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06. When Boesch retrieves a web page from a merchant after the initial purchase transmission by the customer, Boesch sends a request for data (an object) providing purchase authorization to a CIS (Consumer Information Server). An object is returned that incorporates the user identity for display to confirm that the actual user is the same person as identified in the cookie. Boesch 7:1-44.

Linehan

07. Linehan is directed to doing business for electronic commerce that expands the role of a "thin" consumer's wallet by providing issuers with an active role in each payment by adding an issuer gateway and moving the credit/debit card authorization function from the merchant to the issuer. This enables an issuer to independently choose alternate authentication mechanisms without changing the acquirer gateway. Linehan 3:66-4:7.

Katis

08. Katis is directed to co-branding an on-line electronic payment platform, such as an electronic purse or wallet. Katis 1:14-18.

ANALYSIS

Claims 41, 42, 44, and 45 rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

These claims are to methods facilitating online commercial transactions. Claims 41 and 44 are independent. Claim 41 recites steps including storing, verifying, and transmitting customer information. Claim 44 recites steps

1 including maintaining purchase history, generating an interests profile, and
2 transmitting the profile to a merchant web site. Both claims therefore store
3 and transmit data.

4 The Examiner found that none of the claims referred explicitly to
5 another of the statutory classes, nor did they transform something physical.
6 The Examiner found the recitation of transmission to a web site to be
7 insignificant post solution activity. Answer 6. The Appellant responded that
8 the web site necessarily includes a machine, and that the web site is
9 significant because the claims further recite that the web site allows
10 purchases (claims 41 and 42) or allows personalization (claims 44 and 45).
11 Reply Br. 14-17.

12 Here we disagree with the Appellant. The Supreme Court recently held
13 that claims that explained the basic concept of an activity (hedging) would
14 allow the Appellant to pre-empt the use of this approach in all fields, and
15 would effectively grant a monopoly over an abstract idea. *Bilski v. Kappos*,
16 130 S.Ct. 3218, 3231 (June 2010). Abstract ideas are not patent eligible. *Id.*
17 at 3225.

18 Claims 41, 42, 44, and 45 do no more than lay out the concept of storing
19 and sending data. The claims neither refer to a specific machine by reciting
20 structural limitations that narrow the web site to something more specific
21 than a general purpose computer, nor recite any specific operations
22 performed by the web site that would cause a machine to be the mechanism
23 to allow purchases or customization. Indeed to simply allow any operation
24 requires no machine, only the acquiescence of the one controlling the
25 operation. Absent any specific structural limitations on how the server

1 operates upon the data and on acts to allow operations, these claims recite no
2 more than the abstract concept of sending information and allowing
3 something as a result. As in *Bilski*, a patent including these claims would
4 allow the Appellant to pre-empt the use of this approach in all fields, and
5 would effectively grant a monopoly over an abstract idea.

6 *Claims 36-39, 41, and 42 rejected under 35 U.S.C. § 103(a) as unpatentable*
7 *over Foster.*

8 As to claims 36-39, the Appellant argues Foster has no server and does
9 not use a log to generate an interests profile and disseminate the interests
10 profile to the merchant web sites. The Appellant makes similar arguments
11 regarding claims 41 and 42. Appeal Br. 8-9; Reply Br. 2-4. The Examiner
12 made no findings as to the presence of a server, or of transmission of an
13 interests profile to a web site. Ans. 4. The Examiner's response only found
14 that an interests profile was created, not that it was transmitted. Ans. 6-8.
15 Foster does not appear to transmit this information. FF 02. As both
16 independent claims 36 and 41 in this group require such transmission, we
17 agree with the Appellant that the Examiner failed to present a prima facie
18 case.

19 *Claims 44, 45, and 67-69 rejected under 35 U.S.C. § 103(a) as unpatentable*
20 *over Boesch and Linehan.*

21 Claims 44 and 45 recite that an interest profile that reflects purchases is
22 generated and transmitted to a merchant web site. Neither the contents nor
23 the physical source of the profile is specified. The claims only state that the
24 interest profile "reflects said purchases made by the first user from the

1 plurality of online merchants.” The Appellant argues that the references fail
2 to describe this. Appeal Br. 10-11; Reply Br. 4-7.

3 Here we agree with the Examiner that Boesch generates and transmits
4 such a profile. Ans. 4. In Boesch, the profile is the information sent in
5 making a purchase. FF 04. Since the claims do not limit the contents of the
6 profile other than reflecting purchases, the credit card information and
7 customer identity sent to the merchant form a profile that reflects purchase
8 history by that customer with that credit card.

9 The Appellant also argue lack of reason to combine Linehan with
10 Boesch (Appeal Br. 11; Reply Br. 6) but we find that Linehan describes
11 implementation details for a thin electronic wallet described by Boesch. FF
12 07.

13 Claims 67-69 recite sending a cookie that identifies a user and
14 responding to a request for an object from a retrieved web page with the
15 name of the user. These claims recite the returned information is for display
16 within a web page, but this is merely a statement of intended use as the
17 claims do no recite actually displaying the returned information in the web
18 page. We take notice of the Appellant’s admission that the word “graphic”
19 in claim 67 is meant as “object.” Reply Br. 7-8.

20 The Examiner initially made no findings as to these claims, which the
21 Appellant so argued. Appeal Br. 12. The Examiner responded with findings
22 as to how the art described these claims. Ans. 9-12. The Appellant then
23 argued that the references fail to describe the claims. Reply Br. 8-10. We
24 agree with the Examiner that Boesch describes these steps. FF 05-06.

*Claims 46-52 and 60-64 rejected under 35 U.S.C. § 103(a) as unpatentable
over Katis.*

3 Claims 46 and 60 are the independent claims in this group and both
4 recite providing a reference to a graphic within a merchant site web page
5 where the graphic is served, not by the merchant site, but by an information
6 service provider, where the information service provider returns a single
7 selection action button as a graphic. The Appellant argues Katis does not
8 describe this.

9 We agree with the Appellant. The Examiner cites a portion of Katis that
10 describes the processing of an electronic wallet, but does not describe the
11 contents of a merchant web page, much less describing a reference to a
12 graphic stored on an information provider site within the web page. Ans.
13 12-13.

14 CONCLUSIONS OF LAW

15 Rejecting claims 41, 42, 44, and 45 under 35 U.S.C. § 101 as directed to
16 non-statutory subject matter is in not error.

17 Rejecting claims 36-39, 41, and 42 under 35 U.S.C. § 103(a) as
18 unpatentable over Foster is in error.

19 Rejecting claims 44, 45, and 67-69 under 35 U.S.C. § 103(a) as
20 unpatentable over Boesch and Linehan is not in error.

21 Rejecting claims 46-52 and 60-64 under 35 U.S.C. § 103(a) as
22 unpatentable over Katis is in error.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 41, 42, 44, and 45 under 35 U.S.C. § 101 as directed to non-statutory subject matter is sustained.
- The rejection of claims 36-39, 41, and 42 under 35 U.S.C. § 103(a) as unpatentable over Foster is not sustained.
- The rejection of claims 44, 45, and 67-69 under 35 U.S.C. § 103(a) as unpatentable over Boesch and Linehan is sustained.
- The rejection of claims 46-52 and 60-64 under 35 U.S.C. § 103(a) as unpatentable over Katis is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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